

REMARKS

Thorough examination of the application is sincerely appreciated.

Applicant's claims were amended to remove European-type phraseology and address various formalities, as well as to clarify and particularly point out the patentable subject matter of the present invention.

According to the Office Action, claims 1 was rejected under 35 USC 102(b) **[it is believed that the examiner meant 35 USC 103(a)]** as being obvious over US Patent 5,748,674 (hereinafter "Lim") in view of US Patent 6,807,229 (hereinafter "Kim") and further in view of US Patent 5,345,476 (hereinafter "Tsujimoto"). In response, without conceding any statements or waiving any arguments in the Office Action, claim 1 is canceled thereby obviating the rejection.

Further according to the Office Action, claims 2, 3, 10 and 12 were rejected under 35 USC 102(b) **[it is believed that the examiner meant 35 USC 103(a)]** as being obvious over Tsujimoto in view of Kim. Still further according to the Office Action, claims 4 and 11 were rejected under 35 USC 102(b) **[it is believed that the examiner meant 35 USC 103(a)]** as being obvious over Tsujimoto in view of Kim and further in view of Lim.

In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a prima facie case of obviousness in accordance with the established cases and statutory law.

Referring to page 3 of the Office Action, the examiner points to Tsujimoto's abstract for the alleged disclosure of Applicant's feature of "a first adder, a second adder, a decision device and a feedback equalizer arranged to form a first feedback loop," as recited in claim 2. Applicant's representative has carefully reviewed the Tsujimoto patent and failed to find such a

disclosure in the patent, contrary to the examiner's remarks. If the examiner disagrees and believes otherwise, s/he is respectfully requested 1) to specifically point out where such a disclosure can be found in Tsujimoto; 2) to provide an affidavit stating facts within his/her personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Tsujimoto can't be supported by the record.

Referring to page 4 of the Office Action, the examiner points to Tsujimoto's abstract for the alleged disclosure of Applicant's feature of "the second adder, the decision device, and a filter arranged to form a second feedback loop," as recited in claim 2. Applicant's representative has carefully reviewed the Tsujimoto patent and failed to find such a disclosure in the patent, contrary to the examiner's remarks. If the examiner disagrees and believes otherwise, s/he is respectfully requested 1) to specifically point out where such a disclosure can be found in Tsujimoto; 2) to provide an affidavit stating facts within his/her personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Tsujimoto can't be supported by the record.

In addition, nowhere does Tsujimoto teach or suggest the following feature of "the filter being in parallel with the feedback equalizer to compensate for a delay introduced by the feedback equalizer such that the second feedback loop is free of the delay associated with the first feedback loop," as recited in Applicant's claim 2. The examiner apparently relies on Kim to cure this deficiency.

Kim fails to cure Tsujimoto, because it does not refer to either a first feedback loop/second feedback loop or the filter being in parallel with the feedback equalizer to compensate for a delay introduced by the feedback equalizer.

If the examiner disagrees and believes otherwise, s/he is respectfully requested 1) to specifically point out where such a disclosure can be found in Kim; 2) to provide an affidavit stating facts within his/her personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Kim can't be supported by the record.

Furthermore, it is unclear whether the examiner relied on personal knowledge of the facts or those of a skilled artisan in the statement that "it would have been obvious ... to modify Tsujimoto in view of Kim ..." on page 4 of the Office Action. If this is the case, then "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 1371. The MPEP provides guidelines for relying on official notice and personal knowledge, which the Examiner did not follow in this case:

The rationale supporting an obviousness rejection may be based on common knowledge in the art of "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art ...

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

See MPEP §2144.03. If the rejection is maintained, it is respectfully requested that the examiner provide an affidavit stating facts within his personal knowledge or an affidavit by a skilled artisan.

It is respectfully submitted that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Analyzing the references according to the above roadmap, first the examiner did not offer any motivation or suggestion to modify or combine Tsujimoto and Kim except for the unsupported, conclusory remark that "it would have been obvious ... to modify Tsujimoto in view of Kim ... in order to alleviate the large amount of current that is consumed in order to operate the DFE." It is not clear what the basis was for such a statement. There is absolutely no motivation or suggestion to combine the references, except on the basis of the impermissible hindsight and knowledge gleaned from Applicant's invention.

Second, there is no reasonable expectation of success because the prior art references are not combinable.

Third, Tsujimoto and Kim, even when combined, do not teach all of the Applicant's features as recited in claim 2, for example. As argued above, the Applicant's features are not taught or suggested in the prior art references, and their combination is deficient in teaching or suggesting all the claim limitations.

Therefore, the cited references fail to render obvious the claimed invention, because the above-identified criteria are not met. The claimed invention, according to claim 2, is thus distinguishable over the cited references.

Analysis of new independent claim 13 is analogous to the one of claim 2, as presented hereinabove. To avoid repetition, claim 13 will not be discussed in detail with the understanding that it is patentable at least for the same reasons as claim 2. Applicant, therefore, respectfully requests withdrawal of the rejection and allowance of claim 13.

Claim 3 depends from independent claim 2, which has been shown to be allowable over Tsujimoto and Kim. Accordingly, claim 3 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claim 3 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

Claim 4 depends from independent claim 2, which has been shown to be allowable over the prior art references. Lim is not relied upon in the Office Action to teach or suggest Applicant's features in independent claim 2. Hence, Lim does not cure the deficiencies in Tsujimoto and Kim. Accordingly, claim 4 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claim 4 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

In view of the above, it is respectfully submitted that Tsujimoto, Kim and Lim, whether alone or in combination, do not anticipate or render obvious the present invention.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited. However, if for any reason this application is not considered to be in

condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the number listed below prior to issuing a further Action.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

By /LARRY LIBERCHUK/
Larry Liberchuk, Reg. No. 40,352
Senior IP Counsel
Philips Electronics N.A. Corporation
914-333-9602

November 14, 2006